

No. 15249

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

C. S. JOHNSON COMPANY,

Plaintiff-Appellant,

vs.

MERLE W. STROMBERG, dba CALIFORNIA BATCHING
EQUIPMENT Co., DOE I, DOE II, and DOE III,

Defendant-Appellee.

OPENING BRIEF OF PLAINTIFF-APPELLANT.

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OPENING BRIEF OF PLAINTIFF-APPELLANT.

JURISDICTION.

The jurisdiction of the District Court is alleged in Paragraph I of the Complaint [Tr. p. 3], as follows:

“This action arises under the patent laws of the United States of America and this Court has jurisdiction thereof under 28 U. S. C. 1338(a).”

The jurisdiction of the District Court is admitted in Paragraph I of the Answer [Tr. p. 10], as follows:

“Answering paragraph I of the Complaint, Defendant admits that this action arises under the patent laws of the United States and that this Court has jurisdiction thereof.”

The jurisdiction of the District Court is also established by Finding of Fact No. 3 [Tr. p. 78].

This Honorable Court of Appeals has jurisdiction to review the final judgment of the District Court on appeal, according to 28 U. S. C. 1291.

STATEMENT OF FACTS.

The Case.

This is a suit for infringement of United States Letters Patent 2,138,172 [Tr. p. 42] for a Batching Apparatus, invented by Charles S. Johnson. The patent is based on an application filed February 10, 1937, and which issued on November 29, 1938. The patent expired on November 29, 1955.

By stipulation [Tr. pp. 26, 27, 148], it was agreed that the aggregate and cement weigh hopper and scale portions of the Stanton Ready Mix plant at Stanton, California, which was manufactured and sold by Defendant [Tr. p. 242], were typical of such portions of substantially all of the other plants manufactured and sold by Defendant and of the two-scale, central cement weigh type described in the patent in suit. The trial accordingly proceeded with primary relation to the Stanton plant, which is illustrated in Plaintiff's Exhibits 12, 13 and 14 and on pages 39-41 of the Transcript.

By stipulation [Tr. pp. 29, 151], it was also agreed that the trial would proceed on the basis of claims 1 and 5 only, and that a count for unfair competition would not be urged. Claim 1, shown in Plaintiff's Exhibit 15, is a broad claim which covers not only the Stanton plant but the other plants referred to in the preceding paragraph. Claim 5, shown in Plaintiff's Exhibit 17, is a much more specific claim which covers the Stanton plant and only one of Defendant's other plants.

From the above it will be understood that claim 1 must be held valid and infringed if Plaintiff is to be given substantial relief. The upholding of claim 5, although also much desired by Plaintiff, will result in greatly diminished relief since claim 5 covers two plants only.

Claims 1 and 5 were held invalid by the trial court, solely on the ground of an alleged prior public use at a batching plant constructed and operated by strangers to the present action at 235 Alabama Street, San Francisco, California [Findings of Fact and Conclusions of Law, Tr. pp. 78-84].

The Parties.

Plaintiff and Defendant are competitors engaged in the business of manufacturing batching plants for sale to purchasers, such as ready-mix concrete companies, who use the plants to batch (proportion) concrete. Plaintiff and Defendant are manufacturers and fabricators only, and do not themselves engage in concrete batching operations.

Plaintiff is a corporation having a principal place of business at Champaign, Illinois. Defendant is an individual doing business in Los Angeles under the fictitious name California Batching Equipment Co.

The Art to Which the Invention Relates.

The invention relates to the concrete manufacturing art.

Concrete is comprised of a mixture of gravel, sand, water and cement. Good concrete comes from a correct proportioning of the ingredients and from a thorough dispersal of the cement so that every particle of gravel and sand, called aggregates, is coated with cement when put into place in a form or the like.

Particularly during the past two decades plants, commonly called batch plants, have been used to proportion the concrete ingredients in batches of the proper weight for introduction into a concrete mixer. The mixer is commonly mounted on a truck, called a "transit-mix" or "ready-mix" truck, but is also frequently located blocks

or miles from the batch plant as for example a road paving job. In the latter type of operation, known as "dry batching," the batched ingredients are hauled dry in open top dump trucks from the batch plant to the paving mixer at the site.

Although the Trial Court did not at first appreciate the fact [Tr. p. 191], it is emphasized that the commercial concrete batching art bears no relation to small home-style concrete mixing operations. A batching plant of the type here in question will turn out many tons of materials [Tr. p. 116] in a matter of seconds. One company having twenty-three (23) batch plants [Tr. p. 389] turns out fourteen thousand (14,000) *tons* of concrete in an ordinary working day [Tr. p. 412], or an average of over six hundred (600) tons per day per plant.

The concrete batching art is much more exacting and difficult than is commonly appreciated. The aggregates must be prepared, graded, analyzed and stored with the utmost care [Tr. pp. 111, 169]. The cement must be of the proper chemical analysis [Tr. p. 169]. The proportions of the ingredients are designed by skilled engineers, and must be measured out by the batch plant with a high degree of accuracy [Tr. pp. 96, 117] or disastrous consequences might follow.

The cement is the vital and most expensive ingredient in the concrete [Tr. pp. 379, 444], and is also by far the most difficult to handle.

The batching apparatus is the most important part of a batching plant. The quality and quantity of the output of the plant depend upon the ability of its batching apparatus to accurately and quickly proportion the concrete ingredients, and upon the manner in which the ingredients are discharged into the mixer or other receptacle.

That part of the batching apparatus in which the aggregates are weighed is called the aggregate hopper. The cement is weighed in the cement hopper.

The Invention.

Pre-mixing.

Johnson's primary contribution to the concrete batching art, as set forth in the patent in suit, may be summarized as follows:

JOHNSON TAUGHT THE ART HOW TO MAKE A BATCHING APPARATUS WHICH WOULD PRE-MIX OR INTERMINGLE THE CONCRETE INGREDIENTS AS IT DISCHARGED THEM AND BEFORE THEIR INTRODUCTION INTO THE WAITING TRUCK OR MIXER, without sacrificing the great advantage of separate weighing of the cement [Specification of the patent in suit, Tr. p. 42, particularly at p. 1, col. 2, lines 14-29, and p. 3, col. 1, lines 13-41]. That pre-mixing is of tremendous importance and value cannot be seriously questioned [Tr. pp. 129-131, 400, 405, 434, 440]. The importance of weighing the cement completely separately from the aggregate, in order to achieve accuracy, is also beyond question [Tr. pp. 97, 114, 257, 344, 444].

The apparatus invented by Johnson, while effecting pre-mixing and maintaining completely separate cement weighing, also effects many other desirable results. Some of these results, and some of the problems solved by pre-mixing, will be set forth in the following paragraphs.

(a) JOHNSON SOLVED AIR POLLUTION PROBLEMS CREATED BY CONCRETE BATCHING OPERATIONS. Cement is highly subject to being blown away by the wind, which has the undesirable effect of polluting the air with cement dust. This was stated by the witness Pinne, who is superintendent of the largest rock company west of the Mississippi [Tr. pp. 389,

391], to be a big problem [Tr. p. 402] with relation to plants *other* than the Johnson central cement flow type. The problem is not only present at the batching plant, but in trucks as a result of the so-called "dry batching" operations [Tr. p. 399] where the ingredients are hauled dry, in open trucks, from the batch plant to a mixer which may be miles away. By surrounding the discharging cement with aggregate and thus protecting it from the wind [Tr. p. 187] and by causing the aggregates to gravitate from their weigh hopper around and into the cement gravitating from its weigh hopper so as to cause the pre-mixing or intermingling of the ingredients [Tr. pp. 129, 131, 360, 402-403, 457], dusting is greatly minimized and substantial amounts of cement are prevented from blowing out of the open-topped dry batch trucks [Tr. pp. 381, 382, 400, 402, 404].

(b) JOHNSON SOLVED THE PROBLEM OF GETTING THE INGREDIENTS INTO THE FINAL MIXER IN SUCH CONDITION THAT THEY WILL MIX PROPERLY. The two biggest factors here are "balling" of the cement [Tr. pp. 130, 309, 401, 404], and "gumming" of the cement on the mixer blades or on the interior wall of the mixer drum [Tr. pp. 185, 256, 434, 440]. Defendant's own expert testified that these problems are solved by pre-mixing the ingredients [Tr. pp. 434, 439, 440], which is just what Johnson has done. Such pre-mixing is even more important with modern ready-mix trucks than it was formerly [Tr. p. 405]. The present invention not only results in pre-mixing, however, but it *insures* that the cement will never enter the mixer ahead of the aggregate (since the aggregate discharge gate is necessarily beneath the cement discharge gate) and ball or gum with the

rinse water which is always present in a mixer [Tr. p. 404]. As the result, it was testified that Johnson-type plants do not cause balling or gumming [Tr. pp. 321-322], although balling has been so severe with other plants as to necessitate redesign of the mixer blades [Tr. pp. 327, 328].

(c) JOHNSON SOLVED THE PROBLEM OF MIXING CONCRETE WITH GREATER SPEED. Defendant's own expert testified that the time required for mixing is of consequence and may be of the essence [Tr. pp. 436, 454, 455], and this was corroborated by other witnesses [Tr. pp. 300, 407]. The patented construction, because it causes pre-mixing of the ingredients, results in a shorter period of time required for final mixing [Tr. pp. 130, 256, 298, 406, 440].

(d) JOHNSON SOLVED THE PROBLEM OF PRE-SHRINKING THE INGREDIENTS BEFORE THEIR INTRODUCTION INTO THE MIXER TRUCK. It takes 47 cubic feet of loose aggregate and cement to make 27 cubic feet of concrete [Tr. p. 119]. A much bigger payload will therefore result, for a mix truck of a given volume, if the smaller ingredients are caused to fill the voids in the larger ingredients [Tr. p. 10] *before* introduction into the mix truck. This is called pre-shrinking, and is a necessary consequence of the pre-mixing effected with the present invention. Pre-shrinking is also caused by the introduction and pre-mixing of water from the surrounding water ring [Tr. pp. 109, 110, 119, 120, 204].

(e) JOHNSON SOLVED THE PROBLEM OF CORRECTLY INTRODUCING WATER INTO THE MIXER. Defendant's own expert testified that the introduction of water is "very critical" [Tr. p. 451]. Johnson's solution to this critical problem was to surround the falling

shaft of commingled cement and aggregate with a ring or tube of angularly-inwardly directed water. It is emphasized that particularly in "wet-batching" operations the water introduction means [Patent specification, p. 3, col. 2, lines 16-47] co-operates [Tr. p. 204] with the discharge means, which effect cement-aggregate commingling in a falling shaft-like stream, to provide the desired pre-mixing and pre-shrinkage of the ingredients, and to prevent gumming of the cement on certain parts of the batching plant.

(f) JOHNSON SOLVED THE PROBLEM OF GETTING ALL OF THE CEMENT FROM THE WEIGH MEANS TO THE FINAL MIXER. Cement is a peculiar material. It tends, even when dry, to hang up wherever it can [Tr. pp. 99, 437, 452] instead of flowing where desired. It sticks or "gums" at any point where moisture is present [Tr. p. 399]. Furthermore, as previously stated, it is subject to being blown away any time it is exposed to the wind [Tr. pp. 128, 129]. Any of these three factors may operate to prevent *all* of the vital cement from reaching the final mixer, which will result in incorrect proportioning *even if the weighing operation is perfectly accurate*. Johnson's solution to all three of these problems was (1) to locate the cement weigh hopper directly above the delivery point so that a short vertical flow path [Tr. pp. 100, 452] and consequent minimized hanging up would result, and (2) to surround and intermingle the discharging cement with the aggregate and thus not only wipe surfaces clean of cement [Tr. p. 453] and minimize gumming, but also protect the cement from wind loss and dusting [Tr. pp. 187, 381, 382, 402].

(g) JOHNSON SOLVED THE PROBLEM OF REDUCING PLANT HEIGHT AND SIZE. A low batching plant, and a narrow one, can be constructed at minimum cost [Tr. p. 374]. Defendant himself admits that the plant size is a minimum [Tr. p. 377] when the cement is located in the center, as in the patented construction, instead of off to one side.

The patented construction has given Plaintiff great commercial success in a field where, obviously, purchasers buy with care and as the result of performance and quality instead of mere advertising and sales promotion. Since Plaintiff became active in the western states [Tr. p. 281] it has sold therein plants of the type covered by the patent and representing about 45% of the available business [Tr. p. 282]. The patented construction has not been employed by the major competitors of the Plaintiff [Tr. p. 284]. This is a strong indication that the patent has been well respected since, even after two decades, the claimed construction is still the ideal—the ultimate one and the one most desired in its field [Tr. pp. 133, 413].

It is believed that the above will convince this Honorable Court that Johnson made as great an invention as it is possible to make in the field of concrete batching. Here is a case where the whole clearly exceeds the sum of its parts to provide numerous great advantages which are not present in the elements taken alone. There was nothing obvious about freely and independently mounting a weigh hopper within another weigh hopper as Johnson has done—it went directly contrary to the belief in the art that a weigh hopper is intended to contain ingredients and *not* another weigh hopper.

The Alleged Anticipations.

The patents and publications cited in the answer [Tr. p. 13], and in a subsequent notice under 35 U. S. C. 282 [Tr. p. 46], are to be found in Defendant's Exhibit B. Although Defendant even went so far as to cite a seed planter (Patent 1,289,120) as an anticipation, in no reference (relating to either analogous or non-analogous art) is there disclosed or suggested either a hopper movably mounted within another hopper, or the combination thereof with a water ring. In fact, nowhere in the record save in Johnson's patent is there disclosed a water ring for a concrete batching apparatus or anything comparable thereto, or a suggestion that the cement and aggregates in a concrete weigh batcher be pre-mixed or intermingled as they are discharged from the batcher.

The only prior art touched upon by the Defendant at the trial was Johnson's earlier patent No. 1,687,499, and another file reference, Robb patent No. 1,750,244 [Tr. pp. 171 *et seq.*, 232 *et seq.*].

Testimony relating to the alleged prior public use at the Alabama Street plant is to be found on pages 472-598 of the Transcript. Defendant's documentary evidence in support of such use comprises Defendant's Exhibits A and F-P inclusive.

Summary of Events Prior to and During Trial.

Because of an important question concerning the failure by Defendant to give Plaintiff notice relative to the Alabama Street plant, as required by 35 U. S. C. 282, this Summary and the Transcript of Record are necessarily unusually complete relative to activities prior to trial.

The present action was filed on August 25, 1954 (fifteen months before the patent expired), it having been Plaintiff's desire to obtain, in an early trial, not only

damages but also an injunction against Defendant. Plaintiff's desire for an early trial and injunction will be readily appreciated when it is understood that batching plants cost from fifteen to seventy-five thousand dollars [Tr. p. 283].

Plaintiff was thwarted, in its attempt to obtain an early trial and thus an injunction substantially before expiration of the patent, because of difficulty in getting the case on calendar and because of a long postponement of the trial date. Although Plaintiff did its best to obtain an early trial date, the case was originally set for trial on July 25, 1955, or not until eleven months after filing of the action. Pursuant to local Rule 12 of the United States District Court for the Southern District of California, Plaintiff filed its trial memorandum [Tr. p. 16] in the Judge's chambers on July 20, 1955, and was completely ready for trial on the specified date. Defendant, however, filed no memorandum at that time or until many months later [Tr. pp. 53-75].

Because of the fact that a preceding case on the Court's calendar lasted longer than expected, the present case was crowded off calendar and did not finally come to trial until March 13, 1956, by which time the patent in suit had expired. The relief sought both at the trial and in this Court, therefore, is damages for infringement which took place prior to expiration of the patent, Plaintiff's demand for an injunction having become moot.

Not only did Defendant fail to file a trial memorandum prior to the original trial date of July 25, 1955, but he continued for a long period of time thereafter to fail to prepare for trial. This failure was so palpable that his then attorney, H. Calvin White, Esq., was forced to withdraw from the case with the consent of the Court [Tr. pp. 43-46].

On December 8, 1955, several months after Mr. White's withdrawal, Plaintiff's attorney William D. Sellers, Esq., received a telephone call from R. Douglas Lyon, Esq., indicating that he had been retained by Defendant to try this case [Tr. p. 50]. Mr. Lyon filed, on February 10, 1956, a notice under 35 U. S. C. 282 [Tr. p. 46], in which certain patents were listed as anticipations. Mr. Lyon thereafter (February 24, 1956) filed a Motion for Continuance [Tr. p. 47], based on certain possible prior public uses [Tr. p. 48]. This motion was opposed by Plaintiff [Tr. p. 49], and was denied. Neither the patents cited in the notice under 35 U. S. C. 282, nor the possible prior public uses alleged in support of the motion for continuance, were relied upon by Defendant at the trial.

The trial began on March 13, 1956. The first three days of the trial [Tr. pp. 90-471] were devoted to testimony by expert and other witnesses, concerning the questions of infringement and of invention over prior patents (particularly the Johnson Patent No. 1,687,499 and Robb Patent No. 1,750,244) cited as anticipations. However, during the first day of trial [Tr. p. 157], Mr. Lyon, for the first time, make reference to the alleged prior public use at the Alabama Street plant, which presents a primary question before this Honorable Court on appeal. After a protracted discussion [Tr. pp. 157-166], the Court indicated [Tr. p. 166] that it would permit testimony concerning the Alabama Street plant.

Such evidence was brought in on the fourth day of trial [Tr. pp. 472-599], just three days after Plaintiff first heard about it. Plaintiff's motion to strike the evidence, based upon 35 U. S. C. 282, was denied [Tr. pp. 495-503].

The trial court recessed the case until April 23, 1956, at which time final arguments were held [Tr. pp. 604-650].

SPECIFICATION OF ERRORS.

1. The District Court erred in holding claims 1 and 5 of Johnson Patent 2,138,172 invalid and void.

2. The District Court erred in holding that a prior public use of the invention defined by claims 1 and 5 of Patent 2,138,172 more than two years prior to the filing date of said patent has been established, and in holding that said claims 1 and 5 fail to define any invention over such prior public use.

3. The District Court erred in admitting into evidence, under 28 U. S. C. 1732, or any other law or rule, Defendant's Exhibits A, F, G, H, I, J, K, L, M, N, O and P, comprising photostats of engineering drawings and shop orders allegedly relating to a concrete batching apparatus allegedly constructed and operated at 235 Alabama Street, San Francisco, California. Such exhibits were admitted at pages 554, 561, 562, 564-566 and 571-577 of the Transcript, and were objected to by Plaintiff on the following grounds:

(a) That the exhibits are hearsay, and the witness Bodinson, called in support of such exhibits, was a mere youth at the time of the making of such exhibits, and had no knowledge of their making [Tr. pp. 550, 552, 554]. A representative objection is as follows [Tr. p. 554]:

"Mr. Sellers: I object, your Honor. There has been no showing that he was present when the drawing was made. There has been no showing he knows it was made to scale, there has been no showing he knows it was accurate. He is looking at a drawing in order to do this. It is a matter of opinion. I move the answer be stricken."

(b) That the witness Bodinson was in no position to know the policy of the company at the time of the making of the exhibits, and thus could not know if they were made in the regular course of business [Tr. pp. 550, 551, 553, 570]. A representative objection is as follows [Tr. p. 550]:

“Mr. Sellers: Your Honor, I object to that. He didn’t say he saw him do that. There has been no basis for saying he knew he drew it.

The Court: Aren’t these documents admissible under the document rule? I think I read it to you the other day. All in the world you have to establish is that you keep a written memorandum, it is customary to keep a written memorandum in your files, and it speaks for itself. He has testified that they keep the drawings. He doesn’t have to testify he knows them. He doesn’t have to testify he knows anything about the drawing.

Mr. Sellers: He testified the company has kept them. He said he started to work when he was 16 or 17, but had nothing to do with them at that time and he was in no position to know the policy of the company at that time.

The Court: He doesn’t have to show the policy of the company.

Mr. Sellers: Well, your Honor, he is president now and he can state what the policy has been since he has been president, but how can he state the policy prior to that time in the absence of a showing that he knew it?”

(c) That the exhibits were secondary evidence, and Plaintiff had no opportunity for verification [Tr. p. 555].

Further objections to the admission of these exhibits were made by Plaintiff at pages 474, 556, 561, 562, 563, 565, 566, 567, 570, 571, 572, 574 and 575 of the Transcript.

4. The District Court erred in admitting any evidence relative to prior public use of the invention defined by claims 1 or 5 of Patent 2,137,172, and particularly relative to any plant located at 235 Alabama Street, San Francisco, California, despite the failure of Defendant to comply with the provisions of 35 U. S. C. 282. Such evidence comprised the testimony of the witnesses Murasko, Cornett and Bodinson, reported at pages 472 to 598 of the Transcript, and also comprised the exhibits referred to in the preceding paragraph, No. 13. It was objected to, and was the subject of a motion to strike, on the ground of no prior notice under 35 U. S. C. 282, at pages 162-166, 473 and 495-503 of the Transcript. A representative objection is as follows [Tr. p. 473]:

“Mr. Sellers: Your Honor, I should like to object to this entire line of testimony for the reasons we have previously discussed. There has been no notice.”

5. The District Court erred in finding that the evidence, establishes the existence, construction, or mode of operation of an apparatus at 235 Alabama Street, San Francisco, California, prior to February 10, 1935, and more than two years prior to filing of patent application Serial No. 125,167, which matured into United States Letters Patent 2,138,172.

6. The District Court erred in finding that the existence, construction, or mode of operation of an apparatus at 235 Alabama Street, San Francisco, California, was conclusively established beyond a reasonable doubt

by the oral testimony of each of the witnesses Vernon Murasko, E. F. Cornett and Fred W. Bodinson.

7. The District Court erred in finding that the existence, construction, or mode of operation of an apparatus at 235 Alabama Street, San Francisco, California, was conclusively established and fully corroborated by the documentary evidence Exhibits A, F, G, H, I, J, K, L, M, N, O and P.

8. The District Court erred in finding that the elements of claim 1 of United States Letters Patent 2,138,172 were contained in an apparatus at 235 Alabama Street, San Francisco, California, prior to February 10, 1935, and more than two years prior to the filing of patent application Serial No. 125,167, which matured into United States Letters Patent 2,138,172, and in finding that the elements of said apparatus at 235 Alabama Street, San Francisco, California, functioned together with the same mode of operation to produce the same result as the apparatus defined by claim 1 of the United States Letters Patent 2,138,172.

9. The District Court erred in finding that an apparatus at 235 Alabama Street, San Francisco, California, prior to February 10, 1935, and more than two years prior to the filing of patent application Serial No. 125,167, which matured into United States Letters Patent 2,138,172, contained all of the elements of claim 5 of United States Letters Patent 2,138,172, excepting for "instrumentalities to supply water to the flowing shaft of aggregates in a tubular stream surrounding said aggregates and flowing into same at an angle thereto," and in find-

ing that such elements functioned together with the same mode of operation to produce the same result as the apparatus defined by claim 1 of United States Letters Patent 2,138,172.

10. The District Court erred in finding that the addition of "instrumentalities to supply water to the flowing shaft of aggregates in a tubular stream surrounding said aggregates and flowing into same at any angle thereto" to the elements allegedly present in the apparatus at 235 Alabama Street, San Francisco, California, would have been obvious at the time to a person having ordinary skill in the art, and did not involve invention.

11. The District Court erred in giving full credence to the testimony of each of the witnesses Vernon Murasko, E. F. Cornett and Fred W. Bodinson.

12. The District Court erred in finding that claims 1 and 5 of United States Letters Patent 2,138,172 fail to define any invention not embodied in a batching apparatus at 235 Alabama Street, San Francisco, California.

13. The District Court erred in finding that prior to February 10, 1935, and more than two years prior to the filing of patent application Serial No. 125,167, which matured into United States Letters Patent 2,138,172, there was constructed and operated publicly, openly and for commercial purposes at 235 Alabama Street, San Francisco, California, a batching apparatus characterized by a main hopper and an auxiliary hopper disposed within the main hopper with separate weighing mechanisms for each hopper.

14. The District Court erred in failing to find that the invention defined in United States Letters Patent 2,138,172 enjoyed great commercial success, and that the same is evidence of invention in the patented construction.

15. The District Court erred in failing to find that claim 1 of United States Letters Patent 2,138,172 is valid and infringed by Defendant.

16. The District Court erred in failing to find that claim 5 of United States Letters Patent 2,138,172 is valid and infringed by Defendant.

17. Findings of Fact 7-24, inclusive [Tr. pp. 79-83], are erroneous because:

(a) They were based on evidence not noticed under 35 U. S. C. 282, and admitted as the result of and abuse of discretion by the Trial Court.

(b) They were based on hearsay documentary evidence not properly admitted under 28 U. S. C. 1732(a) or any other law or rule.

(c) They were allegedly supported by conflicting and unreliable oral testimony.

(d) They relate to an apparatus which was uncertain and non-anticipatory in construction and operation, not proved beyond a reasonable doubt, not publicly and openly operated, and not clearly non-experimental.

18. Conclusions of Law I, II and III [Tr. p. 84] are erroneous for the reasons set forth in the preceding paragraph, No. 17.

ARGUMENT.

POINT I.

The Trial Court Erred in Finding the Evidence on the Apparatus at 235 Alabama Street, San Francisco, California, to Be Such, as a Matter of Law, as to Invalidate Claims 1 and 5 of Johnson Patent No. 2,138,172.

The Claims in Suit.

As hereinbefore pointed out, Johnson taught the world how to make a concrete batching apparatus which *pre-mixed or intermingled* the cement and aggregates as they were discharged, *substantially eliminated dusting, reduced gumming, reduced mixing time, pre-shrunk* the batch, and maintained *accuracy* of weighing.

In his patent 2,138,172, Johnson claimed his invention in the light of the concrete batching art then existing (This Brief, pp. 3-5).

In determining whether claims 1 and 5 have been anticipated by the evidence in the record Plaintiff urges that certain requirements of the claims must be particularly borne in mind. The claims are reproduced below with those requirements underlined:

1. In a batching apparatus of the class described, in combination, a main hopper to receive aggregate material, an auxiliary hopper disposed within the main hopper, weighing mechanisms one for each hopper, and means for connecting the hoppers with the weighing mechanism therefor so that each hopper may move independently relatively to the other and the materials contained therein.

5. In a batching apparatus of the class described, a main hopper to receive coarser aggregate material,

an auxiliary hopper to receive cement disposed so as to discharge the cement onto and into the coarser aggregate material, discharge means for each of said hoppers, the same being concentrically disposed and serving to produce commingling of the cement and coarser aggregate, means whereby the quantity of the cement in the cement hopper and the quantity of coarser aggregates in the main hopper therefor may be accurately measured independently, means for discharging each of said hoppers to effect the commingling action referred to as the aggregates pass from the hoppers flowing in a shaft-like stream while the hoppers are discharging, and instrumentalities to supply water to the flowing shaft of aggregates in a tubular stream surrounding said aggregates and flowing into same at an angle thereto.

Burden of Proof.

The burden of establishing invalidity of a patent shall rest on a party asserting it (35 U. S. C. 282).

Also, as stated by this Honorable Court in *Whiteman v. Mathews*, 216 F. 2d 712 (C. A. 9, 1954):

“the burden of proof imposed upon a party tendering the issue of prior public use is a heavy one. It is not satisfied by a mere preponderance of the evidence, but is borne successfully only if the evidence is clear and satisfactory—perhaps beyond a reasonable doubt.”

We submit that the evidence offered by the Defendant on the so-called Alabama Street plant is NOT clear and satisfactory, let alone beyond a reasonable doubt, and that it fails to establish an anticipation of claims 1 and 5 of the Johnson patent, 2,138,172.

We also submit that the evidence offered by the Defendant was not such as to support the conclusion that claims 1 and 5 of the Johnson patent 2,138,172 fail to define any intention over the alleged prior use.

The Evidence.

The trial court, in making its Findings of Fact 7 through 15, 17, and 19 through 24 [Tr. pp. 79-83], erroneously found that a prior use had been established and that the constructional details of the Alabama Street batching apparatus *prior to February 10, 1935*, were conclusively established. It then erroneously concluded that claims 1 and 5 were anticipated by the alleged public use, and that they failed to define any invention over the alleged prior use.

The Prior Art Patents Relied Upon by Defendant.

Although prior to the trial Defendant had alleged numerous prior art patents and publications which appear in Defendant's Exhibit B, the only ones touched upon at the trial were Johnson's earlier patent 1,687,499 and the Robb patent 1,750,244 [Tr. pp. 172-176, 232-235, 438-440, 463]. Both of these patents were considered by the Patent Office during the prosecution of Johnson's application for patent 2,138,172 [Pltf. Ex. 11].

Concerning the earlier Johnson patent 1,687,499, the witness Wright said that it did not disclose a hopper within a hopper [Tr. p. 173], that there were no weighing means and that there was no suggestion of pre-mixing or intermingling the ingredients. Rather, there was a "ribboning" effect [Tr. pp. 172-175, 232-233].

Concerning the Robb patent 1,750,244, Defendant's own expert, Wisniski, stated that its apparatus provided

only as much mixing or intermingling action *as there would be in any gathering hopper* [Tr. pp. 438-440, 463], and that in the Robb construction an intermingling must take place *in the collecting hopper* [Tr. pp. 462-463]. He did not even suggest that an intermingling or pre-mixing took place at the *discharge* of the Robb apparatus.

However, when asked about the *discharge* of the Johnson type batching apparatus where the cement falls into the converging streams of aggregate, he answered, "I am sure it intermingles" [Tr. pp. 455-457].

Murasko's Testimony.

Murasko, at the time of his testimony, had known the defendant Stromberg for three years [Tr. p. 514], Stromberg being a business caller upon Murasko's employer [Tr. p. 515].

Stromberg had not asked Murasko if he knew of a plant having a cement hopper in the center of the aggregate hopper until after Stromberg had made contact with the witness Cornett [Tr. p. 515].

Murasko worked at the Alabama Street plant from 1931 until the last day of May, 1942, first as a plant operator and later as superintendent [Tr. pp. 474, 490, 515]. When Murasko became superintendent, Cornett became the operator [Tr. p. 490]. This relationship continued *for six years* [Tr. p. 515] until Murasko left in 1942.

After Defendant's Exhibit A was removed from in front of him [Tr. p. 485], Murasko made a sketch to illustrate his recollection of the batching apparatus at the Alabama Street plant [Deft. Ex. E, which sketch, of course, has no more force or effect than Murasko's oral

testimony]. The batching apparatus was used to charge a stationary one cubic yard mixer [Tr. p. 494].

While describing his sketch, he said that the baffles at the bottom of the cement compartment came to within about 4 inches of the aggregate gate [Tr. p. 487], and that the cement hopper discharge was approximately 12 inches above the aggregate hopper discharge [Tr. pp. 488-489].

In answer to leading questions Murasko also stated that the Alabama Street batching apparatus contained a cement hopper inside the aggregate hopper [Tr. pp. 485-486], and that there were separate *scales* connected to each hopper [Tr. p. 486].

Murasko also stated that the water was inserted into the mixer *in one steady stream* [Tr. p. 492], that it *made no difference* if the water went in first *because it was only a one yard mixer*, and that it wouldn't cause any balling *in that size mixer* [Tr. p. 494].

Cornett's Testimony.

The witness Cornett, a skiploader operator for a construction company, offered no explanation as to how and when he had been contacted regarding this action. All of his testimony was given with Defendant's Exhibit E before him.

Cornett worked for the owners of the Alabama Street plant from 1930 until 1947, except for a period during the depression when he worked on a dredge [Tr. pp. 517, 526]. He first worked with them as a truck driver and then as operator for the Alabama Street Plant [Tr. pp. 518, 526, 527]. He had never seen the interior of the plant prior to going to work in it [Tr. p. 529].

In answer to an inquiry concerning events outside the plant at or about the time he went in as an operator, Cornett replied, "I don't remember. I was just the mixer man upstairs and I had nothing to do with any other part of the business. They would call for a mix and I would mix it up, and that's all I know" [Tr. p. 525]. (This sharply contrasts with Murasko's supposed recollection of business transactions outside the confines of the plant while he was the operator.) While Cornett was an operator, Murasko was his superintendent [Tr. p. 525]. He worked under Murasko *for six years* [Tr. p. 591] until Murasko left in 1942 [Tr. p. 530]. **THUS CORNETT IS IN NO POSITION TO TESTIFY AS TO THE DETAILS OF THE BATCHING APPARATUS PRIOR TO 1936, A DATE MUCH LATER THAN THE REQUIRED FEBRUARY 10, 1935 DATE, OR TO FIX DATES PRIOR TO 1936. ALTHOUGH HE CLAIMS 1933 OR 1934 TO BE THE YEAR HE WENT INTO THE PLANT, THESE DATES WERE UNSUPPORTED AND ARE NOT CONSISTENT WITH THE SIX YEAR PERIOD STATED BY BOTH HIMSELF AND MURASKO [Tr. pp. 515, 591].**

In describing the batching apparatus he operated, Cornett said that the cement flowed right *about* the middle of the aggregate, and into a big V chute where the *cement hit the chute about three-quarters of the way up* and went in right with the aggregate [Tr. p. 522]. He was also quite positive in stating that the cement and aggregate did *not* intermingle or mix at the discharge gate and *only mixed down in the chute* [Tr. pp. 540, 542, 543].

Although he had no recollection as to the details of the aggregate discharge gate, he twice stated that the dimensions of the cement hopper outlet were 12 x 18 [Tr. pp. 588, 589].

On cross-examination he stated that Murasko had failed to mention that the air operated ram for the cement discharge gate extended into the aggregate hopper and was covered by a generally horizontal baffle plate [Tr. pp. 594, 596]. When it was pointed out to him that this would produce an open area in the encircling wall of aggregate, he replied "No, because it falls over the top and *comes back together again*" [Tr. p. 596].

Cornett also stated that the cement gate air ram was mounted on a bracket secured to the aggregate hopper [Tr. pp. 594, 596]. When it was pointed out to him that this would affect the accuracy of the weighing of the cement hopper, his explanation was that the ram "is mounted on flexible springs" [Tr. p. 595]. When it was then pointed out to him that he could not have completely *independent* movement of the aggregate and cement hoppers and was asked how the cement could be weighed accurately, his reply was "Your scales are set that way" [Tr. pp. 595, 596].

As to the water insertion means, he testified that just a single stream of water was used and that no attempt was made to encircle the aggregate stream with water [Tr. p. 591].

Bodinson's Testimony.

Bodinson testified that he is the present owner of the company in whose files the prints and shop orders comprising Defendant's Exhibits A and F through P were found.

Bodinson also testified that he had nothing to do with the drawings or prints at the time they were made [Tr. p. 579], and that at no later date did he compare them with the Alabama plant to make certain that they identify that in detail [Tr. p. 580].

As to the plant itself he testified that it

“was open all around at the base and had a stairway from the ground floor up to the batch floor, and from there on it was covered with galvanized sheeting for a short distance, and then it went into wood structures which housed all the sand and gravel in the bins to make the weigh floor” [Tr. p. 577].

Defendant's Exhibits.

There being no testimony as to the contents of Defendant's Exhibits A and F through P other than which was read from the documents themselves, any attempted explanation as to what they show must rely upon pure conjecture. Suffice it to say that there is no showing of a concrete weigh batcher in which the cement is discharged onto and into the aggregate at the point of discharge, there is no suggestion of a water encircling means and there is no showing of an aggregate batcher having a single discharge opening.

There is also no showing of a weigh batcher in which one discharge gate is spaced 12 inches above the other discharge gate—as testified to by Murasko, or of a cement batcher having a 12 x 18 discharge outlet—as testified to by Cornett. The only cement batcher discernible has a round opening 10 inches in diameter and a 13 x 13 plate for closing it. There are no baffles discernible which terminate 4 inches from the aggregate discharge gate.

Defendant's Exhibit K also indicates that the aggregate hopper contained an *integral cement compartment* instead of a separate cement hopper. See Sheet No. 4 thereof which reads:

“One 6-ton weigh hopper—with cement compartment and 120 gallon water tank integral—per dwg. ‘L-2348’—and consisting of:

1 Hopper—Complete per details . . .”

**The Evidence Relating to the Alabama Street
Plant Is Conflicting.**

The Trial Court in its Findings of Fact 10, 11, 12, 13, 14, 15, 17 and 19 [Tr. pp. 80-83], found that the evidence establishes the construction and mode of operation of the batching apparatus at the alleged Alabama Street plant prior to February 10, 1935, and that the facts as to it were conclusively established and fully corroborated by the witnesses, Murasko, Cornett and Bodinson and by Defendant's documentary exhibits. It takes no more than a cursory examination of the evidence to determine that these findings are clearly erroneous.

The testimony of the witness Murasko, who had known the Defendant for three years before the trial, does not by itself support the above findings. Without benefit of personal records, he glibly testified as to circumstances alleged to have existed at least twenty-one years before the trial. But even at that he failed to establish that the apparatus at the alleged Alabama Street plant anticipated Johnson's invention. MURASKO DID NOT EVEN SUGGEST THAT THE BATCHING APPARATUS AT THE ALABAMA STREET PLANT PRE-MIXED OR INTERMINGLED THE CONCRETE INGREDIENTS AS THEY WERE DISCHARGED. The only thing he suggested about the Alabama Street apparatus was that it made no difference as to how the ingredients were introduced into their one yard size mixer [Tr. p. 494].

Cornett's testimony lends no support whatever to Murasko's testimony. He failed to establish that his recollection was based on circumstances existing prior to February 10, 1935. The unsupported 1933-1934 dates he gave are inconsistent with the assertions made by both himself and Murasko to the effect that Cornett was only

an operator for six years before Murasko left in 1942 [Tr. pp. 515, 591], and Cornett's assertion that he had never seen the interior of the plant prior to going to work in it [Tr. p. 529].

Regardless of point of time, however, Cornett positively stated that the cement and aggregate in the Alabama Street apparatus *did not intermingle or mix* at the discharge gate *and only mixed down in the chute* [Tr. pp. 540, 542, 543]. Cornett also testified that the aggregate hopper contained a generally horizontal baffle plate for covering the air operating ram for the cement discharge gate, and that the ram "is mounted on flexible springs" secured to the *aggregate* hopper [Tr. pp. 594-596]. When it was then pointed out to him that this would not permit *independent* movement of the cement and aggregate hoppers, Cornett's only reply was "Your scales are set that way" [Tr. pp. 595, 596].

Bodinson testified that he had found Defendant's Exhibits A and F-P in his company's files, that he had nothing to do with them at the time they were made [Tr. p. 579] and that at no time had he compared them with the apparatus at the alleged Alabama Street plant [Tr. p. 580].

No one testified as to the contents of Defendant's Exhibits A and F-P other than to read titles from the prints themselves. No one testified that said exhibits disclosed a concrete batching apparatus in which the cement was discharged onto and into the aggregate material to produce commingling of the cement and aggregate, or that the hopper discharge means were concentrically disposed.

Although the witness Bodinson, in answer to leading questions, said that Defendant's Exhibit I disclosed an aggregate weigh hopper having an independent cement hopper in the center and that it pertained to the con-

struction of the Alabama Street plant [Tr. p. 564], Defendant's Exhibit K indicates on Sheet No. 4 thereof that the Alabama Street plant had only one weigh hopper with an *integral* cement compartment. Regarding the latter exhibit, Bodinson stated that it "spells out in detail, every bolt, nut, drawing number, bearing, *hopper*, general description of everything that goes into the construction of that particular order" [Tr. p. 566].

Defendant's Exhibit A shows a cement hopper with a round discharge opening 10 inches in diameter, and Defendant's Exhibit F shows a 13 x 13 plate for a cement hopper gate. Thus they do not conform to Cornett's testimony that the cement hopper at the Alabama Street plant had a 12 x 18 discharge outlet [Tr. pp. 588, 589].

It is inconceivable that solely upon this confused and conflicting evidence the trial court could make the aforementioned Findings of Fact, especially in view of the heavy burden of proof placed upon a Defendant raising the highly technical defense of a prior public use. They are clearly erroneous and should be so found.

Finding of Fact No. 7 is also urged to be clearly erroneous. There is not a shred of evidence to establish that the batching *apparatus* at the alleged Alabama Street plant was "operated publicly, openly and for commercial purposes." The only evidence on this point was that of Bodinson who testified that the plant was covered with galvanized sheeting from the batch floor to the wood structures which housed the sand and gravel in the bins [Tr. p. 577]. The fact that the exterior of a *plant* is open to public view is in no way an indication that its *internal apparatus* is open to public view.

The Evidence Does Not Establish Invalidity of
Claims 1 and 5 of Johnson Patent 2,138,172.

On the above evidence alone, the District Court has concluded to be invalid two claims to an invention which constituted a basic step forward in the art of concrete batching, and which step forward has withstood the test of time.

It is strongly urged that the trial court's conclusion was incorrect, and that claims 1 and 5 are not anticipated by the Alabama Street plant or by the prior art patents and publications.

Referring first to claim 1 (This Brief, p. 19), there is no teaching in the prior art patents and publications of "an auxiliary hopper disposed within the main hopper," or of the combination thereof with "weighing mechanisms one for each hopper." Assuming that such elements were present in the Alabama Street plant, it has *not* been established that there were present "means for connecting the hoppers and the weighing mechanism therefor so that each hopper may move *independently* relative to the other and the materials contained therein."

The witness Cornett testified [Tr. pp. 594-596] that the aggregate and cement hoppers of the Alabama Street plant *were connected* to each other by springs. Such connections must necessarily adversely affect the accuracy of weighing by preventing *independent* movement of each hopper relative to the other.

With relation to claim 5 (This Brief, pp. 19-20), the above-mentioned spring connections mean that the Ala-

bama Street plant incorporated no “means whereby the quantity of the cement in the cement hopper and the quantity of coarser aggregates in the main hopper therefore may be *accurately* measured *independently*.”

Claim 5 is also highly specific to commingling or pre-mixing of the cement and aggregate. It recites that the cement hopper is “disposed so as to discharge the cement *onto* and *into* the coarser aggregate material.” It recites discharge means “concentrically disposed and serving to produce *commingling* of the cement and coarser aggregate.” It additionally recites “means for discharging each of said hoppers to effect the *commingling* action referred to *as the aggregates pass from the hoppers* flowing in a shaft-like stream while the hoppers are discharging.”

Claim 5 thus recites not only the vital commingling, or pre-mixing, but also that such commingling occurs “as the aggregates pass from the hoppers.” This is in direct contrast to the testimony of the witness Cornett [Tr. pp. 540-543; This Brief, p. 24] that there was *no* intermingling at the discharges of the cement and aggregate hoppers at the Alabama Street plant. If there was any intermingling of cement and aggregate at such plant, it did not occur until the materials hit the chute [Tr. pp. 540-543; This Brief, p. 24] leading into the mixer.

In addition to the above, the Alabama Street plant did not incorporate [Tr. pp. 492, 591] the water means required by claim 5, as follows: “instrumentalities to supply water to the flowing shaft of aggregates in a tubular

stream surrounding said aggregate and flowing into same at an angle thereto.”

That the prior art patents and publications did not anticipate claim 5 is clear (This Brief, pp. 21-22), there being no suggestion therein of commingling at concentrically arranged discharges, or of a water ring around the discharging shaft of cement and aggregates.

In view of the above it is respectfully submitted that the prior art, including the Alabama Street plant, does not anticipate either claim 1 or claim 5.

It is further submitted that claims 1 and 5 define invention over the prior art, reference being made to pages 5 to 10 of this brief. The invention was clearly not “obvious” under 35 U. S. C. 103, either over the prior art patents or the Alabama Street plant or a combination thereof. In this connection it is pointed out that Findings 20 and 21 [Tr. p. 83] were the only ones made relative to the question of invention and obviousness as distinguished from anticipation—and these findings involved the water ring (claim 5) only. The Findings 20 and 21 are believed to be clearly erroneous in view of the fact that Defendant presented no evidence whatever about the water ring.

POINT II.

The Trial Court Abused Its Discretion by Admitting Evidence Relative to the Alabama Street Plant Despite Failure by Defendant to Comply With 35 U. S. C. 282.

Title 35, United States Code, Section 282, paragraph 3, reads as follows:

“In actions involving the validity or infringement of a patent the party asserting invalidity or non-infringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires.”

The quoted portion of Section 282 of the Patent Act of 1952 made several changes in prior law (Sec. 69 of Repealed Title 35, U. S. C.). A first change was to strengthen greatly the thirty-day notice rule by excluding not only alleged anticipations, unless properly noticed, but also patents attempted to be introduced “as showing the state of the art”. The common practice of bringing in “state of the art” patents, without notice, and previ-

ously permitted by such cases as *Jacuzzi Bros., Inc. v. Berkeley Pump Co.*, 191 F. 2d 632 at 637 (C. A. 9, 1951), was thus abolished by the 1952 act.

A second change, and one with which the present case is primarily concerned, appears to give the Trial Court discretion relative to the introduction of such evidence. This change is made by the following sentence: "In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires." Plaintiff has not been able to find any reported decision which interprets this portion of Section 282, so the present case is apparently one of first impression.

Plaintiff fully appreciates that it is not entitled to reversal unless there was an abuse of whatever discretion was given by the statute to the Trial Court. It is submitted, however, that an abuse was clearly present under the instant set of facts.

Defendant's Conduct Prior to Trial Did Not Entitle Him to a Favorable Exercise of the Trial Court's Discretion.

As stated previously (This Brief, pp. 11-12), Defendant not only failed to prepare for trial prior to the original trial date of July 25, 1956, even to the extent of not filing the trial memorandum required by local Rule 12 of the District Court, but his conduct prior and subsequent to such original trial date was such that his then attorney, H. Calvin White, Esq., was forced to withdraw from the case with the consent of the Court. Mr. White's affidavit in support of the withdrawal motion [Tr. pp. 43-45] reads as follows, in part:

"On these matters I have experienced controversy, misunderstanding or disagreement with defendant,

and I have found myself unable to obtain from defendant definite authorization to do those things which I consider necessary for proper presentation of defendant's case from the standpoint of the Court, defendant and myself. Most recently I had been unable to learn from defendant whether defendant would appear at the trial as set for July 25, 1955, after I had advised defendant that his appearance, in my opinion, would be necessary.

"On July 21, 1955, I informed defendant by registered mail of the intention of his attorneys to withdraw from the case and recommended the appointment of substitute attorneys. On July 27, 1955, I again wrote to defendant advising him the case was scheduled for further setting on September 12, 1955, and suggested that substitute counsel appear on that date. I have received no response to that letter. On August 29, 1955, I wrote defendant asking him to advise me whether substitute counsel would appear in this Court on September 12, 1955, for further setting of the case. No response to this letter has been received."

The affidavit shows that with the July 25th trial date fast approaching, Mr. White was unable to get cooperation from Defendant—*even to the extent of finding out whether Defendant would show up at the trial.*

The affidavit also shows that for a period of over six weeks, Mr. White was unable to receive any response to a registered letter, and several follow-up letters, written to Defendant [Tr. pp. 44 and 45]. Defendant would not even accede to Mr. White's recommendation that substitute counsel be appointed. Since Plaintiff's counsel William D. Sellers, Esq., did not hear from Mr. Lyon until December 8, 1955 [Tr. p. 50], it is to be presumed

that Defendant did not get around to appointing new attorneys until several months after Mr. White was relieved of responsibility by the Court. The presumption is bolstered by the fact that, in a memorandum filed February 24, 1956, Mr. Lyon stated that he had “recently” been appointed as counsel in this action [Tr. p. 47].

Is this the type of conduct that should permit a defendant to come in, in the middle of a trial and without statutory notice, with a surprise public use which could, with adequate and non-dilatory trial preparation, have been discovered in time to prevent prejudice to a plaintiff? It is respectfully submitted that the answer to this question is clearly in the negative.

“Technicality” Issue Raised by Trial Court.

When the foregoing was before the Trial Judge [Tr. pp. 162-166, 495-503], he indicated a belief that Defendant’s conduct might be excused because of a personality clash [Tr. pp. 163, 500] with counsel, and that Plaintiff was merely relying on “technicalities”. Thus the Trial Judge indicated that “We are not trying the attorneys” [Tr. p. 163], and that “what we are trying to do here is not to try cases upon technicalities but upon the facts and with justice” [Tr. p. 164].

As stated by Mr. Sellers, however [Tr. pp. 163-164], the Trial Judge was clearly turning the situation around. It was Defendant’s dilatory conduct that was on trial, not his attorney’s. There was nothing upon which to base the Court’s assumption of a personality clash or any dereliction on the part of Mr. White.

The so-called “technicalities”, recently reaffirmed and strengthened in the Patent Act of 1952 (This Brief, p. 33), are designed to save a plaintiff from prejudice resulting

from just such conduct. Reasons for the prior notice rule, which has been in the law since the early days of the patent system, were stated by Mr. Justice Story in the early Supreme Court case of *The Philadelphia and Trenton Railroad Co. v. Stimpson*, 39 U. S. 448 at 459 (1840), as follows:

“The object of this most salutary provision is to prevent patentees being surprised at the trial of the cause, by evidence of a nature which they could not be presumed to know, or be prepared to meet, and thereby to subject them either to most expensive delays, or to a loss of their cause.”

The thirty day notice rule is no mere “technicality”, but is essential to decent judicial process. A dilatory defendant should be as effectively barred from this defense by failure to give notice as he would be by a statute of limitations, by a requirement that a notice of appeal be filed within a certain period, by some of the rules of this Honorable Court, or by many other so-called “technicalities” in the law.

In contrast to the above, it is Defendant who is trying to take advantage of a “technicality”—which was stated by Learned Hand to be an “anomaly” and “contrary to the underlying theory of the law” (*Gillman v. Stern*, 114 F. 2d 28, 31 (C. A. 2, 1940)). Judge Hand’s statements pertain to situations where the so-called “public” use, by a complete stranger to the litigation, *did not in fact inform the art as to the invention*. Such a situation is clearly present under the instant set of facts. Not even Defendant, despite many years in the field, knew of the Alabama Street plant until recently. Furthermore, the batching apparatus was hidden from view, and spaced well above the ground.

The function and purpose of the patent system is to result in the teaching of inventions to the art throughout the United States. This function is not performed whether the use is intentionally secret, or whether it is in fact not sufficiently public to teach the art *even in the state* (California) *where the use occurred*. Hence the anomaly that an intentionally secret use will not invalidate (*Gillman v. Stern, supra*) whereas an uninforming use may invalidate.

The law may have afforded Defendant the anomalous technicality of trying to invalidate a patent by reason of an alleged construction by a third party for which Defendant is entitled to no credit whatever, and which did not in fact inform the art as to the invention. However, Defendant was afforded this technicality *on condition* of giving notice that he was going to claim it—a condition imposed because of a realization that such a defense is very likely to be based upon stale and un rebuttable evidence. The defense being a technical one and an anomaly, it should only be available to a deserving defendant who properly presents it—especially where it is raised to defeat a long-standing and respected patent that has well performed the purpose of the patent system by teaching the invention to the art throughout the United States and the world.

Admission of Evidence Relative to the Alabama Street Plant Was Prejudicial to Plaintiff.

After the introduction of the surprise evidence, Plaintiff was unable to discover rebuttal evidence relative to the Alabama Street plant. This was because (a) more than two decades elapsed since the critical period, and (b) the plant was destroyed in 1947 [Tr. p. 523]. This,

however, is no indication that Plaintiff was not greatly prejudiced by the surprise evidence.

Under normal procedure prior to trial of a patent action, a plaintiff is given ample opportunity to study thoroughly the documentary evidence to be introduced by a defendant at trial. The plaintiff can thus gain a thorough understanding of such documents, and is in a position to conduct an adequate and effective cross-examination of the witnesses testifying relative to them. This is the great benefit of the 30-day notice rule, particularly where, as here, the defense is based upon stale and un rebuttable evidence.

In the present action Plaintiff was not given 30 days in which to study the documentary public use evidence before cross-examining the witnesses. Plaintiff was not even given a few days in which to study the great bulk of the documentary evidence [Exs. F-O, incl.], although Defendant admittedly knew of the alleged public use by the middle of the week before trial [Tr. p. 157]. Instead, Plaintiff's attorney, Mr. Sellers, was forced to cross-examine the witnesses without having any chance to study the mass of prints and orders relied upon by Defendant, excepting Exhibit A which was introduced three days before the critical cross-examination.

It is pointed out that the documentary evidence comprises relatively hard to read and detailed shop-prints and orders having inscribed thereon many dates, initials, and other things which can only be comprehended after hearing explanations given during well prepared examinations of competent supporting witnesses. The Court itself stated that "I can't read" Exhibit F [Tr. p. 556]. Plaintiff had no opportunity to prepare for such examinations.

In summary, Defendant's failure to comply with 35 U. S. C. 282 deprived Plaintiff of the only recourse it had against this old and un rebuttable evidence. Because of his own grossly dilatory conduct, Defendant should be *permanently* barred from raising this defense and thus causing Plaintiff further delay and expense.

The Trial Court Was Laboring Under a Mistake in Fact and Judgment When It Failed to Grant Plaintiff's Motion to Strike the Evidence Re Public Use, Which Mistake Is Indicative That There Was an Abuse of Discretion.

Immediately after conclusion of testimony relative to the alleged Alabama Street plant by the witness Murasko, the Trial Court invited Plaintiff's Counsel, Mr. Sellers, to enter a motion to strike under 35 U. S. C. 282 [Tr. p. 495]. The motion was made, after which the following discussion occurred.

"The Court: No, I don't want an argument, but I want to ask you a question. Because of the testimony here and the production of this witness, this knowledge will become general among the trade. The next time you attempt to establish a patent or the next time you file a suit for infringement of this patent, if the patent is sustained, they will raise a question whether or not there is prior use. Wouldn't that be a good defense in a subsequent suit?

Mr. Sellers: That would be important were it not a fact that the patent has expired. In other words, we are here seeking damages for past infringement. The patent has expired and—well, there could be more suits.

The Court: You mean to say the only thing you are interested in in this case is damages?

Mr. Sellers: Yes your Honor.

The Court: It is not a question of the establishment of your patent?

Mr. Sellers: The patent has expired, your Honor.

The Court: So what you are fighting for here is damages?

Mr. Sellers: That is correct.

The Court: The motion is denied."

It subsequently appeared [Tr. p. 497] that the Trial Court was under the mistaken impression that patents run for 20 years instead of 17, and was not previously aware that the patent had expired some months before trial of the present action, although fifteen months after filing thereof.

There was also, for a substantial period of time, apparently a failure on the part of the Trial Court to understand that even after expiration of the patent its validity must be upheld if damages for past infringement are to be given [Tr. pp. 498, 499, 508, 509, 511, 513].

The Trial Court also indicated its belief that it would be unjust "at this late date" [Tr. p. 501] to award damages on a patent if it were invalid.

From the above it will be understood that the Trial Judge believed there was *more reason for admitting the evidence and holding the patent invalid after its expiration than before*, so he immediately denied Plaintiff's motion to strike when he discovered that the patent had expired [Tr. p. 496]. It will be apparent to this Honorable Court on appeal that just the opposite is the case, and

that expiration of the patent is instead a strong reason for excluding last-minute evidence brought in by a dilatory defendant.

Regardless of the ultimate outcome of the present litigation, Defendant is (and has been since expiration of the patent) free to copy the patented construction. The only relief here obtainable is damages for past infringement by Defendant. If the Alabama Street plant were a prior public use, it would be available to any other party that Plaintiff could sue for damages for infringement occurring prior to expiration of the patent.

If the patent had not expired, and assuming (for the present portion of the argument only) that the Alabama Street plant were an anticipating plant and a bar, exclusion of the evidence relative to such plant would have been infinitely more detrimental to Defendant than under the present set of facts. This is because a judgment for Plaintiff would in such circumstances have resulted not only in damages but also in the much more drastic and cogent relief of an injunction.

The above mistakes in fact and judgment on the part of the Trial Court are strong evidence that there was an abuse of discretion. Accordingly, and in view of Defendant's conduct and the resultant prejudice to Plaintiff, it is respectfully submitted that all evidence relative to the Alabama Street plant should be permanently excluded.

POINT III.

The Documentary Evidence Relative to the Alabama Street Plant Is Hearsay, and Was Not Properly Admitted Under 28 U. S. C. 1732(a).

Title 28 United States Code, Section 1732(a), reads as follows:

“In any court of the United States and in any court established by Act of Congress, any writing or record, whether in the form of an entry in a book or otherwise, made as a memorandum or record of any act, transaction occurrence, or event, shall be admissible as evidence of such act, transaction, occurrence or event, *if made in the regular course of any business, and if it was the regular course of such business to make such memorandum or record at the time of such act, transaction, occurrence or event or within a reasonable time thereafter.*

“All other circumstances of the making of such writing or record, including lack of personal knowledge by the entrant or maker, may be shown to affect its weight, but such circumstances shall not affect its admissibility.

“The Term ‘business’, as used in this action, includes business, profession, occupation, and calling of every kind.” (Italics ours.)

This subsection is substantially the same as its predecessor, Title 28 U. S. C., 1940 Ed., Section 695, except for changes in phraseology.

Although this statute has been indicated by this Honorable Court to be a liberalizing one (*Arena v. United States*, 226 F. 2d 227, 235 (C. A. 9, 1955)), it is clear that the statute was not intended to open wide the door to avoidance of cross-examination (*Palmer v. Hoffman*,

318 U. S. 109, 114 (U. S. Sup. Ct. 1943)), and is to be applied with caution (*Zacher v. United States*, 227 F. 2d 219, 227 (C. A. 8, 1955); *Wing Wing Foo v. McGrath*, 196 F. 2d 120 (C. A. 9, 1952); *Teter v. Kearby*, 169 F. 2d 808 (C. C. P. A. 1948)).

The Trial Court apparently believed that it was merely necessary to show that such records are customarily present in the files of the company in order to render them admissible [Tr. pp. 550, 551, 573]. That mere presence in the files is not enough is shown by the following decisions:

National Labor Relations Board v. Sharpless Chemicals, Inc., 209 F. 2d 645, 653, 654 (C. A. 6, 1954);

Schmeller v. United States, 143 F. 2d 544, 550 (C. A. 6, 1944);

William Whitman Co. v. Universal Oil Products Co., 125 Fed. Supp. 137, 145 (D. C. Del., 1954).

Present "custom" of keeping records is irrelevant. Instead, the statute specifically requires, before admission of the evidence:

- (1) That it be shown that the records *were made in the regular course of any business*, and
- (2) That it be shown that the making of such records was the regular course of business *at the time* of the act, transaction, occurrence or event, or within a reasonable time *thereafter*.

**There Was No Competent Evidence to the Effect
That the Records in Question Were Made in the
Regular Course of Business.**

The witness Bodinson was relied upon in support of the admission of the documentary evidence [Deft. Exs. A and F-P, incl.] relative to the Alabama Street plant [Tr. pp. 547 through 584]. This in spite of the fact that Mr. Bodinson, in the Court's own words, was only "a boy working around the plant" [Tr. p. 578] at the time in question and *had no knowledge* relative to the exhibits [Tr. pp. 554, 579, 580] or their accuracy. As a school boy of about 17 [Tr. p. 548], he wasn't even present while most of the plant was built [Tr. pp. 576, 577].

Mr. Bodinson subsequently acquired engineering ability, and became an officer of the company [Tr. p. 581] in 1940, or nine years after the plant was allegedly built. Both the witness and the Court, however, stated that the witness was not competent to testify as to company policy before 1940 [Tr. pp. 568, 581]. He, accordingly, was not competent to testify that the records were made in the regular course of business.

**There Was No Competent Evidence That the
Making of Records Such as the Ones in Question
Was the Regular Course of Business at the Time
of the Act or Within a Reasonable Time There-
after.**

It is common engineering practice to make drawings of various forms of a proposed product, and then actually build one such form of product, frequently with changes, in accordance with what is later thought to be most desirable. On the other hand, it is highly uncommon to make drawings *at the time* the product is actually being

built or within a reasonable time *thereafter*, since drawings would be of little or no value unless made *before* the event.

The drawings in question were in all probability, therefore, made before the apparatus was built, if built at all, not *at* the time the apparatus was built or *thereafter*, as the statute requires. Defendant produced no evidence showing that the drawings in question were made at or after the building of the apparatus. Whether the Alabama Street plant was built in accordance with the drawings in evidence, or in accordance with some other drawings, or in accordance with no drawings at all, is not known.

In any event, "records" made before the event do not fall within the wording or intent of the statute. The previously cited cases (This Brief, pp. 43-44) teach that it was the intent of the statute to render more readily admissible records of a *routine* or *clerical* nature, which experience has shown to be highly reliable. This rationale does not apply to relatively complicated drawings and orders, such as Defendant's Exhibits A and F-P, made before the event and which do not "record" anything but what might occur in the future. Hearsay documentary evidence of the type under consideration should be supported by the testimony of a competent witness (subject to cross-examination) who was not an inexperienced boy at the time in question, and who was in a position to know company policy at that time.

For all of the above reasons, the documentary evidence [Deft. Exs. A and F-P, incl.], should have been excluded. It is submitted that the admission of such evidence was clearly prejudicial to Plaintiff, and reversible error.

POINT IV.

Defendant's Infringement Is Clear.

That the infringement was not accidental may be inferred from inconsistencies between the testimony of Defendant [Tr. pp. 342, 343], who said that prior to 1950 he had never seen a batching plant of the central cement hopper type, and that of an unbiased witness [Tr. pp. 395, 396] who said that in January, 1948, his company had batching plants of the centrally positioned cement hopper type and that at that time the Defendant was in charge of their maintenance crew, repairing the batching plants and anything connected with them.

Defendant's infringement of claim 1 was not seriously contested.

Defendant's infringement of claim 5 is obvious from a mere inspection of Plaintiff's Exhibit 18, and from a reading of pages 125 and 126 of the Transcript. Defendant himself admitted [Tr. pp. 359, 360] that there was intermingling at the hopper discharges. The Trial Court was "convinced" that this was the case with relation to Plaintiff's Exhibit 14 [Tr. pp. 361 and 367].

POINT V.

There Is No Necessity of a Remand to the Trial Court for Further Findings.

The District Court stated that it was basing its decision on "all the evidence in the case" [Tr. p. 650], and this may be presumed to include not only the evidence relative to the Alabama Street plant but also relative to the prior art patents and publications [Deft. Ex. B]. Thus, since the Findings relate only to the Alabama Street plant, it is to be presumed that the District Court did not believe the claims to be invalid over the prior art

patents and publications. At any rate, it is submitted to be clear that invention is present over the prior art patents and publications (This Brief, pp. 21-22).

In view of the above, and in accordance with the principles enunciated in *Yanish v. Barber*, 232 F. 2d 939 (C. A. 9, 1956), it is submitted that there is no need to remand the case to the District Court for findings relative to infringement or to invention over the prior art patents and publications.

Conclusion.

It is respectfully urged that the judgment be reversed, that Johnson Patent No. 2,138,172 be held valid and infringed by Defendant, and that an accounting of damages be awarded to Plaintiff, The C. S. Johnson Company.

It is also respectfully urged that Plaintiff be awarded costs and attorney's fees. In this connection, the attention of the Court is invited to pages 650 and 651 of the Transcript.

Respectfully submitted,

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